

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#9/21E.  
2/13/2  
Zuske

In re Application of: :  
Yamakawa, et al. : Examiner: Graybill, D.  
Title: Adhesive and Semiconductor : Reply to Election of Species Requirement  
Devices : Art Unit: 2814  
Serial No.: 09/597,218 : Confirmation No.: unknown  
Filed: 20 June, 2000 :  
Docket No.: TSL 1549 : Date: 7 November, 2001

Commissioner for Patents  
Washington, DC 20231

Sir:

In response to the Office Action dated 30 October, 2001, the applicants request reconsideration based on the following remarks.

**REMARKS**

Claims 1-17 are pending in the application.

The Examiner requested election of species under 35 U.S.C. § 121 to: the species wherein the polymer is a silicone or an epoxy composition.

The applicants respectfully traverse the election requirement as the Examiner has failed to demonstrate either of the criteria necessary for a proper restriction requirement/ election of species requirement. MPEP 803 sets forth the following two criteria for a proper requirement for restriction between patentably distinct inventions:

- (1) The inventions must be independent . . . or distinct as claimed . . . ; and
- (2) There must be a serious burden on the examiner if restriction is not required.

The Examiner failed to satisfy criteria (1) for the following reasons: the Examiner has not given reasons for the contention that the application contains claims to patentably distinct inventions under 35 USC 121, as required by MPEP 816 because

A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given.

The Examiner's remarks, such as "This application contains claims directed to the following patentably distinct species of the claimed invention: The species wherein the polymer is a silicone and an epoxy composition," are mere statements of conclusion. MPEP 816 notes that such statements are inadequate.

Furthermore, the Examiner made no statements as to the alleged independence or distinctness of the claimed invention. Therefore, the Examiner failed to meet criterion (1) by failing to demonstrate the independence or distinctness of the invention as claimed.

The Examiner failed to satisfy criterion (2) for the following reasons:

The Examiner requested restriction/election among 2 species. Patentability searches for each group of claims would have to be repeated if the election were limited as the Examiner required. Therefore, rather than avoiding a serious burden by issuing the present restriction/election requirement, the Examiner is creating a serious burden on the Patent Office via unnecessary duplication of searching effort. An important advantage of pursuing just one application and searching all claims together is that the examination work of the Patent Office would thereby be simplified inasmuch as duplication of search effort would be eliminated. By avoiding such duplication of search effort, the Patent Office saves time and expense.

In view of the foregoing, the Examiner failed to issue a proper restriction/ election of species requirement. A restriction/election of species requirement is inappropriate. Therefore, the applicants respectfully request that the restriction/ election of species requirement be withdrawn.

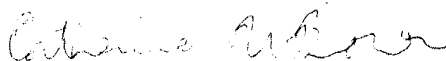
However, if the Examiner should make this requirement final, the applicants provisionally elect to prosecute the species wherein the polymer composition is a silicone composition at this time. The applicants make this election with traverse. The applicants make this election with traverse for the reasons discussed above.

The applicants have particularly pointed out and distinctly claimed the subject matter that they regard as their invention, and the instant invention is novel and unobvious. Reconsideration of the application is requested.

The present response is being submitted within the one month response period for response to the outstanding office action. Although the applicants believe in good faith that no extensions of time are needed, the applicants hereby petition for any necessary extensions of

time. You are authorized to charge deposit account 04-1520 for any fees necessary to maintain the pendency of this application.

Respectfully Submitted,  
DOW CORNING CORPORATION



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2814

<b>CERTIFICATE OF MAILING BY FIRST CLASS MAIL (37 CFR 1.8)</b>		Docket No.
Applicant(s): Yamakawa, et al.		TSL1549

Serial No. 09/597,218	Filing Date FEB 01 2002 June 20, 2000	Examiner D. Graybill	Group Art Unit 2814
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Invention: Adhesive and Semiconductor Devices

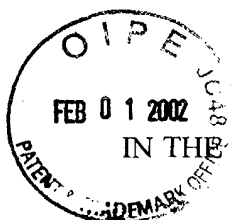
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I hereby certify that this Response to Election of Species Requirement *Assoc. PFI*  
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of  
Yamakawa, et. al.

Serial Number: 09/597,218

Filed: June 20, 2000

Title: Adhesive and Semiconductor  
Devices

Docket Number: TSL1549

) Group Art Unit: 2814

) Examiner: D. Graybill

) Associate Power Of Attorney

) Date: November 8, 2001

Assistant Commissioner of Patents  
and Trademarks  
Washington, D.C. 20231

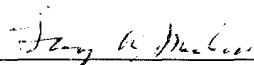
Sir:

I hereby appoint: Catherine U. Brown

Registration No.: 44,565

my associate in the prosecution of the above application and hereby ratify all acts previously  
committed by her in connection herewith.

Respectfully submitted,

  
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Larry A. Milco  
Reg. No. 41,196